

Serial No.: 10/605,225  
Amendment Dated: June 22, 2006  
Reply to Office Action of February 22, 2006

**R E M A R K S**

The Examiner's comments in the February 22, 2006, Office Action have been carefully considered. Reexamination of the present Application in view of the following remarks is respectfully requested.

**Status of Claims**

Claims 1-11 remain in this application.

**Claim Rejections**

Claims 1-11 stand rejected under 35 U.S.C. 102(b) and/or 35 U.S.C. 103(a).

**Section 102(b) - Heller**

Claims 1-4 and 6-10 have been rejected under 35 U.S.C. 102(b) as anticipated by Heller (U.S. Patent No. 2,142,647). The Examiner contends that Heller discloses an ash receiver capable of holding food in either the "ash tray 10 or recessed area 25" in the configuration shown in Figure 1. The Examiner contends that tray 10 functions as a removable cover, since the tube sections to which it is attached can be separated from one another. Additionally, the Examiner contends the underside of the peripheral edge or lip of tray 10 functions as a first cover support as "forming a sealed relation with a surface of the food container (recessed area 25 or the peripheral area which contacts the underside of the lip of tray 10) when the ash receiver is in the configuration shown in Figure 3 and a secondary cover support in the form of a support extension (upper tube 19) formed in the removable cover." The support column (tubes 15-18) is considered to be the secondary mounting platform.

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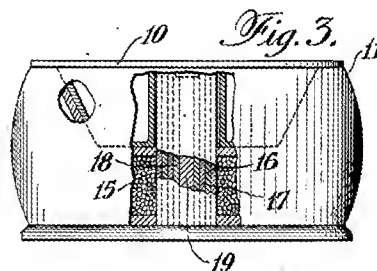
### Applicant's Response

A Section 102 analysis begins with the often-repeated standard:

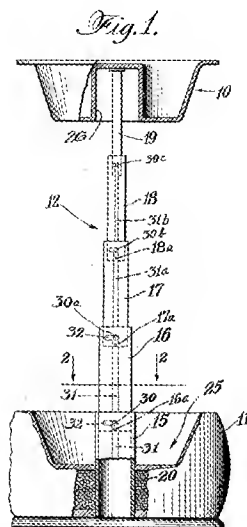
Anticipation under 35 U.S.C. Section 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)

In re Robertson, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). The Examiner's analysis managed to locate a responsive structure for every structural element recited in Claim 1 - unfortunately, to do so improperly requires the deconstruction, if not destruction, of Heller.

The Heller device is "an ash-tray adapted for use on a table provided with means for converting the same into a smoker's stand" (see Column 1, lines 5-7). In the table version, shown in Figure 3, the ash tray 10 is shown fully received by the base member - in fact, a cut-away shows the metal surface of the recessed area to be fully abutted against the outer surface of the ash tray 10. Recessed area 25 simply cannot form any type of "container" other than to contain/receive the ash tray 10 - there is no room to be a "food container."

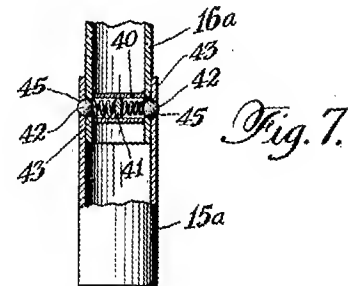


An extendable support 12 is provided to transform the table ash-tray into a floor-stand model - as is depicted in Figure 1. The ash-tray 10 is attached to the uppermost of a series of connected individual, nestable tubes 15-19. "When it is desired



to extend the ash-tray 10 from its collapsed position, as shown in Fig. 3, to the extended position shown in Fig. 1, adapted for floor use as a smoker's stand, it is merely necessary to grasp the tray 10 and pull upwardly to extend the nested support 12" (Column 2, lines 27-32). In addition to the lack of a container, there is no removable cover.

To address this latter structure, the Examiner contends that one could separate two of the intermediate, nestable tubes, relying upon the biased-ball structure shown in Figure 7. Applicant respectfully declines to follow the speculation of the Examiner regarding whether or not they are separable - there is certainly nothing in Heller to suggest the desirability of such separability. In fact, should such a separation occur, the ash tray 10 would not be usable on either table or floor.



As noted above, elements found in Claim 1 are missing from the disclosure of Heller, and Applicant respectfully requests removal of the 102(b) rejections from Claim 1 and the related, dependent claims.

#### **Section 102(b) - Phillips**

The Examiner chose not to explain how the disclosures of Phillips (U.S. Patent No. 5,634,560) apply to the required elements of Claim 1. It is Applicant's observation that in the embodiments having a removable cover, for example Figures 1-4, there would not seem to be either a secondary cover support or a secondary mounting platform for that cover/cover support. For

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the embodiment of Figures 6-8, a non-removable cover is depicted - which of course excludes several other elements of Applicant's invention as described in Claim 1.

Applicant respectfully requests removal of the rejection of Claim 1 under Section 102(b) based upon Phillips.

**Section 103(a) - Heller**

Claims 1-11 have been rejected under 35 U.S.C. 103(a) as unpatentable over Heller in view of the admitted prior art in Jepson Claim 1 - i.e., a sealed relationship between a first cover support and a surface of a food container is well known.

Section 2143 of the Manual of Patent Examining Procedure ("M.P.E.P.") identifies three requirements to establish a prima facie case of obviousness: (1) some suggestion or motivation to modify or combine the reference(s); (2) a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all claim(s) limitations. The overriding rationale for all three limitations is to avoid the temptation of a hindsight analysis.

As has been carefully discussed in the context of the §102(b) rejection based upon Heller, the Examiner has failed to locate, at a minimum, a "container" and a "removable cover". Lacking those elements, one could not possibly find additional required elements, such as a "secondary cover support" formed in the removable cover or a "secondary mounting platform" formed in the food container.

All claim limitations are not taught or suggested, and the Examiner has failed to establish a prima facie case of obviousness. A withdrawal of the Section 103 rejection is respectfully requested.

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**Conclusion**

If there are any questions or other issues that might be resolvable by a telephone call with Applicant's counsel, the Office is invited to place same at the number indicated below.

Respectfully submitted,

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By: \_\_\_\_\_

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